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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/210,472	12/14/1998	GYU-YEONG SON	1399.1001	5435

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EXAMINER

TRAN, THAI Q

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/210,472

Applicant(s)

SON ET AL.

Examiner

Thai Tran

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2002 and 30 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-81 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed April 23, 2002 have been fully considered but they are not persuasive.

In re pages 4-5, applicants argue that it does not appear that Yuen et al is available as a prior art publication or patent under 35 U.S.C. §§102(a), (b), or (e) because Yuen et al is a patent publication and not an issued patent, it does not qualify as prior art under 35 U.S.C. §102(e) and Yuen et al was not published until January 31, 2002, it does not qualify as a prior art publication under 35 U.S.C. §§102(a) or 102(b).

In response, the examiner respectfully disagrees. MPEG§901.03 states that "Any new prior art created by the changes to 35 U.S.C. 102(e) may only be applied against applications that are filed on or after November 29, 2000, and against application filed prior to November 29, 2000 that are pending on November 29, 2000 and are voluntarily published..." Accordingly, Yuen et al is qualify as a prior art under 35 U.S.C. 102(e) until applicants show that this application is not voluntarily published.

Additionally, event if Yuen et al (US 2002/0012525 A1) is not qualify as a prior art publication under 35 U.S.C. 102(e), Yuen et al (US 6,091,884) attached hereto can be used as prior art under 35 U.S.C. 102(e) because both Yuen et al are continuation of application No. 08/176,852.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 16-17, 19-26, 28-35, 37-54, 56-62, and 64-81 are rejected under 35 U.S.C. 102(e) as being anticipated by Yuen et al (US 2002/0012525 A1) as set forth in paragraph #2 of the last Office Action.

Regarding claim 16, Yuen et al discloses a method of reserved recording of an upcoming program while a program preview of the upcoming program is being broadcast (Fig. 5), the method comprising receiving program guide information associated with the upcoming program (page 47, paragraph #0565); receiving, during the broadcast of the program preview (page 47, paragraph #0565), a user command to reserve the upcoming program for future recording; and reserving, in response to the user command, the upcoming program for future recording using the received program guide information (page 60, from paragraph #0708 to page 61, paragraph #0735).

Regarding claim 17, Yuen et al discloses the claimed wherein the program guide information is embedded in the program preview (page 47, paragraph #0565).

Regarding claim 19, Yuen et al discloses the claimed wherein said receiving the program guide information comprises automatically receiving the program guide information for the upcoming program to be broadcast at the future time without another user command requesting the program guide information (page 41, paragraph #0506 and page 42, paragraph #0507).

Regarding claim 20, Yuen et al discloses the claimed wherein said receiving the program guide information comprises receiving the program guide information without storing the program guide information (page 41, paragraph #0506).

Regarding claim 21, Yuen et al discloses the claimed prompting a user for the user command to reserve the upcoming program for future recording during the broadcast of the program preview (page 47, paragraph #0565 and from page 60, paragraph #0708 to page 61, paragraph #0735).

Regarding claim 22, Yuen et al discloses the claimed providing a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed (page 42, paragraph #0510).

Regarding claim 23, Yuen et al discloses the claimed wherein the user command is generated in response to a single action of a user (page 42, paragraph #0510).

Regarding claim 24, Yuen et al discloses a program recording device (Fig. 5) for reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast, the device comprising a memory (RAM 33, page 41, paragraph #0506 and page 42, paragraph #0507) to store program guide information associated with the upcoming program; a user interface (page 42, paragraph #0510 and page 47, paragraph #0565) to receive, during the broadcast of the program preview, a user command to reserve the upcoming program for future

recording; and a controller (the microprocessor controller 31, page 42, paragraph #0510 and from page 60, paragraph #0708 to page 61, paragraph #0735).

Regarding claim 25, Yuen et al discloses a receiver (page 41, paragraph #0506 and page 42, paragraph #0507) to receive the program guide information.

Regarding claim 26, Yuen et al discloses the claimed wherein the program guide information is embedded in the program preview (page 47, paragraph #0565).

Regarding claim 28, Yuen et al discloses the claimed wherein said receiving the program guide information comprises automatically receiving the program guide information for the upcoming program to be broadcast at the future time without another user command requesting the program guide information (page 41, paragraph #0506 and page 42, paragraph #0507).

Regarding claim 29, Yuen et al discloses the claimed wherein the program guide information is not stored as it is received unless in response to the user command to reserve the upcoming program for future recording (page 42, paragraph #0510).

Regarding claim 30, Yuen et al discloses the claimed wherein said controller further prompts a user for the user command during the broadcast of the program preview (page 47, paragraph #0565 and from page 60, paragraph #0708 to page 61, paragraph #0735).

Regarding claim 31, Yuen et al discloses a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed (page 42, paragraph #0510).

Regarding claim 32, Yuen et al discloses wherein the user command is generated in response to a single action of a user (page 42, paragraph #0510).

Regarding claim 33, Yuen et al discloses a recording unit that is operable to record the upcoming program in accordance with the program guide information stored in the memory (page 42, paragraph #0510).

Regarding claim 34, Yuen et al discloses wherein the recording unit comprises a video cassette recorder (page 42, paragraph #0510).

Regarding claim 35, Yuen et al discloses wherein said recording unit comprises a television having a recording unit (page 10, paragraph #0197).

Regarding claim 37, Yuen et al discloses a computer readable storage medium (page 11, paragraph #0199) encoded with a computer program to implement a method of reserved recording of the upcoming program while a program preview for an upcoming program is being broadcast (Fig. 5), the method comprising receiving program guide information associated with the upcoming program (page 47, paragraph #0565); receiving, during the broadcast of the program preview (page 47, paragraph #0565), a user command to reserve the upcoming program for future recording; and reserving, in response to the user command, the upcoming program for future recording using the received program guide information (page 60, from paragraph #0708 to page 61, paragraph #0735).

Regarding claim 38, Yuen et al discloses the claimed wherein the program guide information is embedded in the program preview (page 47, paragraph #0565).

Regarding claim 39, Yuen et al discloses the claimed prompting a user for the user command during the broadcast of the program preview (page 47, paragraph #0565 and from page 60, paragraph #0708 to page 61, paragraph #0735).

Regarding claim 40, Yuen et al discloses the claimed wherein said receiving the user command comprises detecting an input from a user input interface having user selection keys (page 42, paragraph #0510) and the user command is generated in response to only one of the user selection keys being depressed (page 42, paragraph #0510).

Regarding claim 42, Yuen et al discloses the claimed wherein said receiving the program guide information comprises automatically receiving the program guide information for the upcoming program to be broadcast at the future time without another user command requesting the program guide information (page 41, paragraph #0506 and page 42, paragraph #0507).

Regarding claim 43, Yuen et al discloses the claimed wherein said receiving the program guide information comprises receiving the program guide information without storing the program guide information (page 41, paragraph #0506).

Regarding claim 44, Yuen et al discloses the claimed wherein the user command is generated in response to a single action of a user (page 42, paragraph #0510).

Regarding claim 45, Yuen et al discloses the claimed recording the upcoming program in accordance with the program guide information (page 42, paragraph #0510).

Regarding claim 46, Yuen et al discloses a method of reserved recording of an upcoming program while a program preview of the upcoming program is being broadcast (Fig. 5), the method comprising receiving the program preview including program guide information associated with the upcoming program (page 47, paragraph #0565); displaying the program preview (page 47, paragraph #0570); receiving, during the broadcast of the program preview (page 47, paragraphs #0565 and #0566), a user command to reserve the upcoming program for future recording; and reserving, in response to the user command, the upcoming program for



future recording using the received program guide information (page 60, from paragraph #0708 to page 61, paragraph #0735).

Regarding claim 47, Yuen et al discloses the claimed receiving a plurality of program previews for a plurality of upcoming programs (page 41, paragraph #0506, page 42, paragraph #0507 and page 47, paragraph #0565)); and storing the plurality of program previews (page 42, paragraph #0508 and page 47, paragraph #0566); wherein said displaying the program preview comprises sequentially replaying the stored plurality of program previews (page 47, paragraph #0570).

Regarding claim 48, Yuen et al discloses the claimed providing a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed (page 42, paragraph #0510).

Regarding claim 49, Yuen et al discloses the claimed wherein the user command is generated in response to a single action of a user (page 42, paragraph #0510).

Claim 50 is rejected for the same reasons as discussed in claims 16 and 22 above.

Claim 51 is rejected for the same reasons as discussed in claim 23 above.

Claim 52 is rejected for the same reasons as discussed in claims 37 and 40 above.

Claim 53 is rejected for the same reasons as discussed in claim 44 above.

Claim 54 is rejected for the same reasons as discussed in claim 17 above.

Claims 56-60 are rejected for the same reasons as discussed in claims 19-23 above, respectively.

Claims 61-62 are rejected for the same reasons as discussed in claims 25-26 above, respectively.

Claim 64 is rejected for the same reasons as discussed in claim 28 above.

Claim 65 is rejected for the same reasons as discussed in claim 29 above.

Claims 66-69 are rejected for the same reasons as discussed in claims 30-33 above, respectively.

Claims 70-77 are rejected for the same reasons as discussed in claims 38-45 above, respectively.

Claim 81 is rejected for the same reasons as discussed in claims 16-17 above.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 18, 27, 36, 55, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen et al (US 2002/0012525 A1) as set forth in paragraph #4 of the last Office Action.

Regarding claim 18, Yuen et al discloses all the features of the instant invention except providing that the program preview comprises audio data.

The capability of transmitting the audio data along with the video data is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known audio data with the video data of the program preview in order to increase the quality of the program preview by adding audio data.

Claim 27 is rejected for the same reasons as discussed in claim 18 above.

Regarding claim 36, Yuen et al discloses all the features of the instant invention except for providing wherein the recording unit comprises a Hard Disc drive.

It is noted that the capability of recording/reproducing video signal on/from the Hard Disk drive is well known and old in the art and again Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known Hard Disc drive into Yuen et al's system in order to decrease the time in access the desired video signal because Hard Disc drive has random access capability.

Claim 55 is rejected for the same reasons as discussed in claim 18 above.

Claim 63 is rejected for the same reasons as discussed in claim 27 above.

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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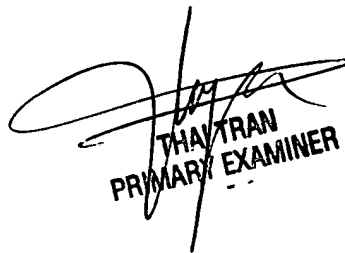
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

TTQ  
July 4, 2002



THAI TRAN  
PRIMARY EXAMINER